
REMARKS

Applicant has reviewed and considered the office action mailed on May 7, 2003 and the references cited therewith.

Claims 1-23 are now pending in the application.

§ 102 Rejection of the Claims

Claims 1-10 were rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Stopperan (U.S. Patent No. 5,428,190) or Casson *et al.* (U.S. Patent No. 5,502,889). Applicant respectfully traverses the rejections of claims 1-10.

Claim 1 recites, "an optically transmissive unit." In contrast, Stopperan, in the abstract, states, "A multilayer rigid-flex circuit board having two or more conductive layers, with at least one rigid circuit board electrically connected to at least one flexible jumper connector or intercircuit connector circuit board, is disclosed." Also, Casson *et al.*, in the abstract, states, "A multilayer circuit board having three or more conductive layers, with at least two conductive layers electrically and mechanically connected by an interconnecting adhesive layer, is disclosed." Hence, neither Stopperan nor Casson *et al.* teach "an optically transmissive unit." Thus, neither Stopperan nor Casson *et al.* teach each of the elements of claim 1, so the office action fails to state a *prima facie* case of anticipation with respect to claim 1. Therefore, applicant requests withdrawal of the rejection and reconsideration and allowance of claim 1.

Claims 2-10 are dependent on claim 1. For reasons analogous to those stated above and elements in the claims, applicant respectfully submits that the office action fails to state a *prima facie* case of anticipation with respect to claims 2-10. Therefore, applicant requests withdrawal of the rejections and reconsideration and allowance of claims 2-10.

Claims 11-23 were rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Yam *et al.* (U.S. Patent No. 6,238,597) or Casson *et al.* (U.S. Patent No. 5,688,584). Applicant does not admit that Yam *et al.* is prior art and reserves the right, as provided for under 37 C.F.R. 1.131, to "swear behind" Yam *et al.* Applicant respectfully traverses the rejections of claims 11-23.

Claims 11-23 are rejected under 35 U.S.C. 102(b). For a U.S. patent to qualify as a reference under 102(b) the U.S. patent must issue more than one year before the filing date of the application to which the reference is being applied. The above referenced patent application that includes claims 11-23 was filed on April 30, 2001. Yam *et al.* issued on May 29, 2001. Hence, Yam *et al.* did not issue more than one year prior to the application date of the above referenced patent application that includes claims 11-23. Thus, Yam *et al.* is not a valid 102(b) reference. Therefore, applicant requests withdrawal of the rejections and reconsideration and allowance of claims 11-23.

Claim 11 recites, "filling at least one of the one or more holes with a material capable of transmitting an optical signal." In contrast, Casson *et al.*, in the abstract, states, "A multilayer circuit board having three or more conductive layers, with at least two conductive layers electrically and mechanically connected by an interconnecting adhesive layer, is disclosed." Hence, Casson *et al.* fails to teach each of the elements of claim 11. Thus, the office action fails to state a *prima facie* case of anticipation with respect to claim 11. Therefore, applicant requests withdrawal of the rejection and reconsideration and allowance of claim 11.

Claims 12-23 are dependent on claim 11. For reasons analogous to those stated above and elements in the claims, applicant respectfully submits that the office action fails to state a *prima facie* case of anticipation with respect to claims 12-23. Therefore, applicant requests withdrawal of the rejections and reconsideration and allowance of claims 12-23.

The office action quotes from a district court case to establish the legal theory of inherency. The inherency theory is only stated in the abstract and is not applied specifically to particular claims. Applicant respectfully traverses the rejections based on the inherency theory for three reasons. First, a district court case is not a proper source of law. Second, a rejection based only on an abstract legal theory not applied with specificity is improper. Third, the inherency theory is not intended to be a substitute for citation of a reference. Therefore, applicant requests withdrawal of the rejections and reconsideration and allowance of claims 1-23.

So Called Prior Art Made of Record But Not Relied Upon

Several patents were cited as pertinent to applicant's disclosure but not relied upon to reject claims. In view of the fact that the patents were not asserted against any claims, applicant need not respond either to the assertion of their pertinence or to any assertion that any of the listed patents constitutes prior art to any pending claim. Applicant expressly reserves the right to challenge any such assertion, should it be included in some future rejection.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone applicant's attorney at 612-371-2109 to facilitate prosecution of the application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743

Respectfully submitted,
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By their Representatives,

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Date May 22, 2003

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CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Non-Fee Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 22 day of May, 2003.

Anne M. Richards
Name

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